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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,004	04/08/2004	Thomas P. Adams	1827.030	9306
23598 7590 09/29/2010 BOYLE FREDRICKSON S.C. 840 North Plankinton Avenue MILWAUKEE, WI 53203				
EXAMINER SHAPIRO, JEFFERY A				
ART UNIT 3653		PAPER NUMBER		
NOTIFICATION DATE 09/29/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

Office Action Summary

Application No.

10/821,004

Applicant(s)

ADAMS ET AL.

Examiner

JEFFREY A. SHAPIRO

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 11-17 is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/24/10 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-21 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 6,318,537 B1) in view of Geib et al (US 5,997,395), further in view of Nickerson (US 6,109,416).

Regarding Claims 18 and 26, Jones discloses the coin redemption and dispensing machine (10), providing a printed receipt of the transaction as mentioned at col. 6, lines 43-54, that sorts and dispenses coins into any number of receptacles, as illustrated at figures 3-9, the machine having a housing, as illustrated in figure 1, a first intake area (14), a dispensing area for coins (22) as illustrated at figure 1 and mentioned at col. 4, lines 66, 67.

Regarding Claim 18 and 26, Jones also discloses a coin processing mechanism (32) as being described in Geib, incorporated by reference into Jones at col. 6, lines 10-16. Geib illustrates a coin processing device at figure 3, such as elements (11-16).

Note that Geib discloses use of a coin till, i.e., a cash drawer (250), as mentioned at col. 12, line 55-col. 13, line 34.

Regarding Claim 18 and 26, Jones discloses a controller (39) electronically connected to the coin processing mechanism at figure 2, that calculates/tabulates totals of coins deposited, as mentioned at col. 6, lines 43-54, and those deposited and dispensed at col. 18, line 50-col. 19, line 8.

Note that Jones discloses a printer at col. 6, lines 43-54.

Note that Jones discloses storing the funds in the form of a card which stores electronic money, at col. 1, lines 15-27. Note that Jones mentions a media reading device at col. 5, lines 25-39.

Regarding Claims 19 and 27, note that Jones' apparatus is construed as being capable of substantially simultaneously tabulating totals of the intake and the dispensing of coins.

Regarding Claim 20, note Jones, figure 3.

Further regarding Claims 23, 24 and 28, Jones discloses comparing amounts of coins dispensed from the machine for the respective user with amounts of coins loaded into the machine by said respective user. See col. 2, lines 9-25.

Note that the term "during a work shift" is considered to be intended use, and that it would have been obvious to dispense coins during a work shift.

Jones discloses storing the funds in the form of a card which stores electronic money, at col. 1, lines 15-27. Note that Jones mentions a media reading device at col. 5, lines 25-39. This card also allows identification of the user and matching with an account for tracking purposes of deposits and withdrawals, i.e., intake and dispensing.

Regarding Claim 25, Jones discloses touch screen (12).

Regarding Claim 18, Jones does not expressly disclose, but Nickerson discloses a cash dispenser (11) with plural bulk hoppers (12, 14, 16) that feed particular denomination coins into plural associated dispensing hoppers (24, 26, 28) from which coins are dispensed to a user/customer. See figure 1 and col. 2, lines 55-col. 3, line 23.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added the bulk hoppers and dispensing hoppers as taught by Nickerson in the coin dispensing apparatus of Jones for the purpose of insuring the coin machine will meet demand for coins to be dispensed.

Regarding Claim 9, Jones discloses an output device for providing the customer with credit in the form of a network interface communicating with a

central computer (200) as illustrated at figure 11 and mentioned at col. 12, line 33-col. 13, line 9, and more particularly, col. 13, lines 5-9.

4. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 6,318,537 B1) in view of Geib et al (US 5,997,395), further in view of Nickerson (US 6,109,416), and still further in view of Doran et al (US 7,653,599 B2).

Jones discloses the system as described above.

Jones does not expressly disclose, but Harris discloses a sweeper mechanism (54) and (116) that skims the coins from the bulk hopper to the dispensing hopper, as illustrated at figures 3 and 6.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added the skimming device as taught by Harris to the bulk hoppers and dispensing hoppers as taught by Nickerson in the coin dispensing apparatus of Jones since Nickerson mentions that motors (18, 20, 22) are energized to cause a coin transport mechanism to move coins from the bulk hopper to the dispensing hopper. It therefor would have been obvious to use Harris' skimmer mechanism to move the coins between hoppers in Nickerson's apparatus as used in Jones' coin processing device.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to

identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/991,685. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both encompass a coin recycling apparatus and method for its use concerning inputting coins into an intake and dispensing coins to an output receptacle for employees in a retail organization or customers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

8. Claims 1-17 and 29 are allowed.

Response to Arguments

9. Applicant's arguments with respect to Claims 18-28 have been considered but are moot in view of the new ground(s) of rejection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY A. SHAPIRO whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stefanos Karmis can be reached on (571)272-6744. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Shapiro/
Primary Examiner, Art Unit 3653

September 26, 2010